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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,300	10/21/2003	Keisuke Miura	17135	6905

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SCULLY SCOTT MURPHY & PRESSER, PC  
400 GARDEN CITY PLAZA  
SUITE 300  
GARDEN CITY, NY 11530

EXAMINER

VRETTAKOS, PETER J

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/690,300

Applicant(s)

MIURA, KEISUKE

Examiner

Peter J. Vrettakos

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9-11-06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

RCE filed 9-11-06.

The application claims priority to Japanese patent applications: JAPAN 2002-311599 10/25/2002 and JAPAN 2003-310628 09/02/2003.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims include limitations not sufficiently described in the specification. For example, figures 6, 18, and 20 provide no direct indication of an initial characteristics measurement device and table reading devices.

The Office cannot assert prior art structure in a rejection toward claimed structure not sufficiently described. It seems as though the claims were written separately (in time and person) from the specification and drawings. Further, what the Applicant claims as "devices" are merely functions that the driving circuit (allegedly element 3 in figure 6) performs. The Applicant is requested to define exactly what physical structure is a table reading device and an initial characteristics measurement device. Are they resistors? Sensors? Where are they described in the specification beyond inferences? A telephone interview could be helpful.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Panescu et al. (6,165,169).**

Panescu discloses a method and system (see figures 39-41; columns 26 and 27) comprising a plurality of treatment tools (20,30), a driving device (176), a resistance value detecting device (174, 178, 184), a memory device (180), a judging device (178,188), a table reading device (178), an operating device (188), a resistance value data selection device (178, 188), a control section (188), a treatment section (12), a connector (18), and a temperature measuring device (temperature sensing intimated in col. 26:27-30 and col. 26:52-53). The ability of the electrodes to sense temperature is further disclosed ("diagnostic capability"... "derivation of an electrical characteristic" i.e. temperature in col. 25:66 through col. 26:1).

Note: the claims repeatedly include limitations toward "devices" with an intended use description such as a "table reading device". This approach to claiming an invention

Art Unit: 3739

is problematic because it only vaguely claims structural limitations by attaching an intended use to the word, "device". It also could be argued that limitations such as "table reading devices" are indefinite and add no new structure to the claim. To this end, the rejection above applies prior art structural limitations liberally, which includes patented structures being asserted above as anticipating more than one of the claimed "devices" as well as some of the "devices" being anticipated by more than one of the patented structures, because of the Applicant's vague style.

**Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Howell (6,695,837).**

Howell discloses a heating treatment system and method with power supply, feedback control, and identifying abilities for disparate surgical tools. Note Howell's device ID circuit (26), which performs identification of the connected device (15). Further, Howell discloses that the device ID circuit is designed to detect three kinds of medical instruments, each of which has a separate identifying resistor (col. 4:40-43).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Vrettakos whose telephone number is 571-272-4775. The examiner can normally be reached on M-F 9-6.

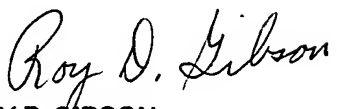
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3739

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pete Vrettakos  
September 14, 2006



  
ROY D. GIBSON  
PRIMARY EXAMINER